



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,336	12/28/1998	GUY A. STORY JR.	80293/40	3308
20277 7590 10/16/2007 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER RETTA, YEHDEGA	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 09/222,336  
Filing Date: December 28, 1998  
Appellant(s): STORY ET AL.

OCT 16 2007

**GROUP 3600**

\_\_\_\_\_  
Michael E. Shanahan  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 1, 2007 appealing from the Office action mailed August 11, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,926,624

KATZ

7-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 10-18, 20-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 11, 21, 31 recites “creating a first license comprising a first cardinality, wherein the cardinality indicates the number of playback devices that can be authorized for playback of associated digital audio content”. Applicant’s specification teaches creating a first license having an associated cardinality that determined the number of playback devices that can be authorized by the license. Also the specification teaches the license is comprised of 32 bit group ID, or other identifier size. Further the specification discloses that each playback device storing a license belongs to a set of one or more playback devices storing the license, and the set being authorized to play the content. The license does not comprise of cardinality according to applicant’s disclosure. According to applicant’s specification the license is associated with the cardinality by authorizing each device storing the identifier (license) to play content that include the same identifier (license). The number of devices that are authorized to play the content (cardinality) is associated with the license. Since the specification does not teach the “license comprising of cardinality”, it is considered new matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in: (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-18, 20-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Katz et al. U.S. Patent No. 5,926,624.

Regarding claims 1-3, Katz teaches creating one or more licenses having cardinality associated with the license, the cardinality indicating the number of authorized playback devices (see col. 12 lines 39-67); transmitting the license, via network connection, to playback devices authorizing playback of the digital audio content with the playback devices (software or hardware) (see fig. 2, col. 11 line 32 to col. 12 lines 67); Katz teaches transmitting configuration data, which includes Group ID, storing the Group ID in the playback devices and authorizing only the playback devices defined by the Group ID (see col. 8 lines 5-62, col. 9 line 13 to col. 10 line 67 and col. 11 line 31 to col. 12 line 66); storing the license in digital audio contents, and determining whether playback of digital audio content is authorized to by comparing the first license with the digital content having the licenses embedded (see col. 13 lines 19-58). Katz teaches that the server (260) creating a targeted header for selected files (the targeted header linked with the corresponding digital information), the header comprises a combination of the descrambling map with the private player IDs corresponding to the targeted playback devices

Art Unit: 3622

etc. (see col. 13 line 30 to col. 14 line 27), storing a first license in second digital audio content and authorizing playback of the second digital audio content with the first set of playback devices; creating a second license having a second cardinality ... (see col. 12 lines 55-64).

Regarding claims 4-6, 14-16 and 25-27, Katz teaches wherein the cardinality is fixed (see col. 11 lines 32-53); variable or unlimited (see col. 12 lines 39-67).

Regarding claims 7, 8, 17, 18, 28 and 29, Katz teaches playback devices comprising a hardware or software devices (see col. 11 lines 19-31 and col. 15 lines 30-62).

Regarding claims 10, 20 and 30, Katz teaches the digital content comprises of video digital programming (see col. 5 lines 45 to col. 6 line 3 and col. 18 line 66 to col. 19 line 4).

Claims 11-13 and 21-23 are rejected as stated above in claims 1-3 respectively.

Claim 24 is rejected as stated above in claim 1.

Regarding claims 31-33, Katz teaches receiving a first license (Group ID) at a playback device, the playback device belonging to a first set of playback devices; (player or group ID), the license comprising (having associated) a first cardinality, wherein a cardinality indicating a number of playback devices that can be authorized for playback of digital content, wherein the first set of playback devices is less than or equal to the first cardinality; storing the first license in the playback device; receiving first digital content, wherein information associated with the first license is embedded in the in the first digital content; and determining whether playback of the received first digital content by the playback device is authorized by comparing the first license stored in the playback device with the first license information embedded in the first digital content; (see col. 8 lines 5-62, col. 9 line 13 to col. 10 line 67 and col. 11 lines 32-53 and col. 12 lines 24-66).

Regarding claims 34-36, Katz teach creating a first license having a first cardinality associated with the license wherein a cardinality indicates the number of playback devices that can be authorized for playback of associated digital content; transmitting information corresponding to the first license to a content provider, a first digital content (audio) (see col. 5 lines 45-65) at the content provider to be embedded with the first license information; transmitting the first license to a first set of playback devices, wherein the first set of playback devices is less than or equal to the first cardinality, the first set of playback devices to render first digital content provider by the content provider based on a match between the first license and the first information embedded in the first digital content(see col. 8 lines 5-62, col. 9 line 13 to col. 10 line 67 and col. 11 lines 32-53 and col. 12 lines 24-66).

**(10) Response to Argument**

Appellant argues “(b)ecause the Examiner has impermissibly inserted words into and/or changed the meaning of the claims on appeal, the rejection with respect to Katz must therefore fail on this basis alone (*i.e.*, because the Examiner's rejection is based on a flawed interpretation and/or is based on terms not present in the pending claims. Thus, the pending rejection is, in fact, not based on the claims actually pending in this appeal). Accordingly, appellant's request that the rejection under 35 U.S.C. § 102(e) be withdrawn”. Appellant asserts that the specification on page 11 lines 10-11 explains that in the license management device 510 creates a license having a cardinality (number of playback devices that are authorized).

Regarding the 112 rejection the specification teaches the license is comprised of 32 bit group ID, or other identifier size. Further the specification discloses that each playback device storing a license (32 group ID or other size) belongs to a set of one or more playback devices

Art Unit: 3622

storing the license, and the set being authorized to play the content. According to Appellant's disclosure the playback devices that art authorized to play a content should have the 32 group ID or other identifier size. According to Appellant "cardinality" is the number of playback devices that can be authorized to play the content, i.e., the playback devices which have the ID.

Therefore, Appellant's specification teaches creating a first license having an associated cardinality that determined the number of playback devices that can be authorized by the license.

In light of the specification and as best understood by the Examiner, the playback devices that include this ID indicate the cardinality: number of playback devices that are authorized. If the license (32 bit Group ID) includes or comprises of cardinality, then which part of the 32 group ID is considered "cardinality"? Is the ID itself a "cardinality"? In short for the license to consist of cardinality, the specification does not teach which part of the 32 bit Group ID provides indication of how many devices are authorized, since the cardinality is associated with number.

Therefore, claim 1 contains subject matter (the license (32 bit Group ID) comprising of cardinality) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Appellant states "Nonetheless, appellant's present discussion below explaining why the pending claims, as presented or properly interpreted (*e.g.*, a license comprising a cardinality) are allowable over Katz. Although the Examiner found these arguments persuasive in the past, appellant reiterates them here for convenience".

Appellant argues that Katz discloses a digital library and a mobile playback device that can be used to play digital content from the digital library (see, for example, Fig. 2. Katz

Art Unit: 3622

discloses that playback devices can be members of one or more groups and include a group ID. See Katz, col. 12, lines 39-67), *however, the Group ID of Katz is merely a number that identifies a group*. Appellant argues that *the Group ID does not indicate a number of playback devices in the group nor does it provide any restriction on the content a particular device may play*, thus, Katz fails to show or suggest a license comprising a cardinality as specified in appellant's pending claims.

As indicated before appellant's specification only teaches (see page 12) the **license comprised of 32 bit group ID, or other identifier size**. Further the specification discloses that each playback device storing a license belongs to a set of one or more playback devices storing the license, and the set of playback devices are authorized to play the digital content, which is the same as Katz's system.

Katz teaches a license management device (Server 260) generating a license (Group ID) and the license transmitted to playback devices (see fig. 2& 10, col. 8 lines 30-63 and col. 12 lines 39-67). Katz further teaches the library server 260 utilizes a set of identifiers (i.e. player ID) for mobile playback devices authorized to receive the selected download data from the library, the library formatting the downloads data that can only be read by mobile devices with these identifiers (see col. 11 lines 39-48). Katz also teaches playback devices logically grouped together using a Group ID and digital information content, software, or configuration data changes targeted to a group of mobile playback devices defined by a group ID. Each Player storing one or more group ID of which the particular player is a member, playback devices of the same group share the same Group ID (see col. 12 lines 39-66). Players with the same Group ID,

Art Unit: 3622

indicates the number of playback devices that are authorized to playback the content (cardinality).

Appellant's argument is *the Group ID of Katz is merely a number that identifies a group and the Group ID does not indicate a number of playback devices in the group nor does it provide any restriction on the content a particular device may play*. In Katz the "cardinality" (number of playback devices authorized), is provided by the Group ID, same as Appellant's claimed invention. However if the Group ID of Katz is not the same as Appellant's 32 bit Group ID, which is the license, Appellant have never indicated which part of the license is considered "cardinality" to patentably distinguish it from the prior art (Katz). Examiner understanding of the association of the license and the cardinality is that every playback device that has the license indicates the cardinality. Therefore, Appellant's 32 bit Group ID is the same as Katz's group ID which indicates the number of playback devices that are authorized to play a content.

Therefore, Katz's *Group ID indicates a number of playback devices in the group and provides restriction on the content a particular device may play*, since only the devices which have the group ID are authorized to play a content.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

YR

Conferees:

Eric Stamber

Raquel Alvarez

  
RETTA YEHDEGA  
PRIMARY EXAMINER